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**Datasheet for the decision
of 19 January 2012**

Case Number: T 1880/11 - 3.5.06
Application Number: 98109085.5
Publication Number: 880088
IPC: G06F 21/00, H04L 29/06
Language of the proceedings: EN

Title of invention:
Data copyright management system and apparatus

Applicant:
Intarsia Software LLC

Opponent:
-

Headword:
Copyright management system/INTARSIA

Relevant legal provisions (EPC 1973):
EPC Art. 109(2), 111(2), 116(1), 113(1)

Keyword:
Substantial procedural violation (yes)

Decisions cited:
G 0007/93

Catchword:
Failure to appoint oral proceedings on the subject of
adaptation of the description after first appeal decision -
see Reasons 2.



Case Number: T 1880/11 - 3.5.06

D E C I S I O N
of the Technical Board of Appeal 3.5.06
of 19 January 2012

Appellant:
(Applicant)

Intarsia Software LLC
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 30 March 2011
refusing European patent application
No. 98109085.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: D. H. Rees
Members: S. Krischer
W. Sekretaruk

Summary of Facts and Submissions

- I. The application 98109085 was refused a first time by the examining division with a decision posted on 4 October 2005.
- II. In board of appeal's decision T408/06 of 24 July 2009, the refusal decision was set aside and the case was remitted to the first instance "with the order to grant a patent on the basis of the main request ... and a description and figures to be adapted thereto".
- III. The examining division issued a communication under Rule 71(3) EPC dated 12 January 2010. In the attached documents, pages 9, 9a and 9b of the description were amended by the examining division in order to adapt the description as required by the board of appeal's decision. In particular, the following sentence was added on page 9b below line 20:
- "The embodiments of figures 2, 3 and 5 do not specify the invention but only related technology."
- IV. In a first letter dated 20 May 2010, the grant documents were said to be approved, but with a request to amend the added sentence on page 9b below line 20 to:
- "The embodiment of figure 5 does not specify the invention but only related technology."
- V. In a communication dated 10 September 2010, the examining division raised an objection under Article 84 EPC.

VI. In a second letter dated 20 January 2011, the applicant requested a new communication under Rule 71(3) EPC wherein the sentence on page 9b below line 20 should be deleted and the other amendments on pages 9, 9a and 9b kept in. There was also a conditional request for oral proceedings.

VII. The application was refused a second time by the examining division with a decision posted on 30 March 2011. The reason for the refusal was lack of clarity in violation of Article 84 EPC.

VIII. The present appeal is directed against this decision.

IX. A notice of appeal and the fee was received on 26 May 2011, together with "abbreviated Grounds of Appeal":

"Thus, to enable immediate allowance under interlocutory review, the Applicant hereby approves the amendments proposed by the Examiner on pages 9, 9a, and 9b as attached to the Communication under Rule 71(3) dated 12th January 2010."

X. A second statement of the grounds was received on 14 July 2011, repeating the approval and the requests.

XI. A third statement of the grounds was received on 9 August 2011. *Inter alia* it was argued that there had been a procedural violation.

XII. The appellant requests (implicitly) that the decision under appeal be set aside and that the communication under Rule 71(3) EPC of 12 January 2010 be reissued.

XIII. In view of the board's decision, the text of the claims is irrelevant.

Reasons for the Decision

1. The appeal satisfies the requirements of the EPC for admissibility, see sections VII-XI above.

2. *Procedural violation*

2.1 In his third grounds of appeal dated 9 August 2011, the appellant submitted that there had been a procedural violation. He complained that the dialogue with the examining division about the adaptation of the description had been improperly stopped by the issuing of a refusal decision.

The appellant further argued that the examining division had itself interpreted the ratio decidendi of the board of appeal's decision and had not permitted any discussion on its interpretation (see page 2, paragraph 2).

The letter ends with the assertion that "not permitting any further written submissions by the applicant" constituted a "procedural violation".

2.2 In its communication dated 10 September 2010, the examining division argued that the amendments of the examining division were "a direct and unavoidable consequence of what has been ordered by the BoA (decision T0480/06, chapter 8)" (see section 2).

2.3 The appealed decision (section 7) argues that:

"the description ... contains subject-matter that does not fall within the scope of the claims since the decision T0408/06, chapter 8 explicitly identifies such subject-matter being not covered by the claims."

2.4 The passage in the board of appeal's decision cited by the examining division reads (T0408/06, section 8.):

Conclusions

8. The board concludes that the claims of the main request satisfy the requirements of the EPC. However, the claims of the said request are understood to relate primarily to the embodiment according to Fig. 4 and the related passages of the description. The description includes further embodiments which are not covered by said claims. For example, the embodiments of Figs. 2 and 3 are understood to relate to a client-side "digital content management apparatus" which is used for the secrecy protection of the digital content, (cf. col.5 1.38-47)."

It follows from this passage that figures 2 and 3 are *understood* to relate to embodiments which are not covered by the claims of the main request.

2.5 At the time when the examining division had to decide on the request for oral proceedings, the following arguments had been presented by the applicant:

"It appears that with the other amendments made on page 9a and 9b, the application is now clearly

adapted to the claims and the statement which was hand-written by the Examiner and amended by the representative seems redundant. There is no specific requirement in the Decision for an explicit positive or negative statement, merely for adaptation of the description. There is a conceivable risk that the negative statement may be adversely construed, however improper that might be, which is why we feel it unhelpful as well as unnecessary." (letter dated 20 January 2011, paragraph 3)

2.6 In order to decide whether the examining division committed a procedural violation, the board has to consider whether the examining division had the discretion to reject the request for oral proceedings.

2.7 Article 116(1) EPC 1973 reads:

"Oral proceedings shall take place ... at the request of any party to the proceedings. However, the European Patent Office may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same."

The only other provision of the EPC allowing rejection of a request for oral proceedings applies only to the Receiving Section (Article 116(2) EPC 1973). Thus the EPC defines only one situation which allows the examining division to reject a request for oral proceedings: the request is for *further* oral proceedings (which applies here; the first oral proceedings before the examining division took place on 8 July 2005); it must be before the same department

(applies here); the parties must be the same (applies here) and the subject of the proceedings is the same. The last condition does not apply here since the claims are different and there is a new subject, namely how to adapt the description and the figures in order to fulfil the order of the board of appeal's decision.

2.8 As to the statement in the appealed decision, section 7:

"The auxiliary request for oral proceedings is not allowed since a point to be discussed is prerequisite for the summons to oral proceedings and the applicant is not entitled to continue discussing issues on which the division has no right to decide. In the present case in view of Article 111(2) EPC the examining division is not entitled to discuss the ratio decidendi of the Boards of Appeal decision T408/06."

Firstly, as follows from the above there is no basis for this to be found in the EPC, in particular not in Article 116(1) EPC 1973.

2.9 Secondly there was in fact clearly a need for and an entitlement to discussion between the examining division and the applicant in this case. At least the following questions could have been discussed during oral proceedings:

- Does the above cited section 8. of the board of appeal's decision belong to the ratio decidendi of the decision?
- Does section 8. leave room for interpretation since the wordings "primarily" and "understood" are used?

- Did the examining division interpret the ratio decidendi of the board of appeal's decision or did it strictly follow the ratio decidendi?
- Does section 8. force the addition of the sentence "The embodiments of figures 2, 3 and 5 do not specify the invention but only related technology." to the description?

2.10 Moreover the outcome of the oral proceedings could clearly have had a decisive influence on the outcome of the examination procedure as a whole. Thus, the rejection of the request for oral proceedings by the examining division constitutes a substantial procedural violation.

2.11 The appellant did not request the reimbursement of the appeal fee. The board could grant the reimbursement even without such a request. According to Rule 103(1)(a) EPC the prerequisites for reimbursement are the allowability of the appeal, equity and a substantial procedural violation. While the first and last of these conditions are satisfied in the present case, the fact that the appellant now does not request more than was in fact offered in the Rule 71(3) EPC communication and so could have been achieved even without the (refused) oral proceedings, means that reimbursement would not be equitable.

3. *The appropriate order*

3.1 The board could only guess at the examining division's reasons for not granting interlocutory revision as requested, since, in accordance with Article 109(2) EPC 1973, it passed the appeal to the board without

comment. The board refrains from making any such guess. *Prima facie* the examining division should have granted interlocutory revision, since the applicant now accepted the text which had been proposed to it. However the board notes that an examining division is not bound, even by an applicant's approval of a text put forward by the division to grant a patent on that text (G 7/93, OJ 1994, 775, Reasons 2.1, penultimate paragraph). Given that the dialogue between division and applicant was brought to a premature end by the untimely issuance of a refusal decision without holding the oral proceedings requested, the board therefore uses its discretion under Article 111(1) EPC 1973 and remits the case to the department of first instance for further prosecution (bearing in mind that the final form of the claims has already been decided).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The application is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

B. Atienza Vivancos

D. H. Rees